



10 SEP 2002

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In re Application of BERTHELON et al. :
Application No.: 10/019,683 :
PCT No.: PCT/EP00/06230 :
Int. Filing: 04 July 2000 :
Priority Date: 06 July 1999 : DECISION ON PETITION
Attorney Docket No.: MERCK 2358 : UNDER 37 CFR 1.47(a)
For: DIHYDROBENZODIAZEPINS AND :
THEIR USE FOR TREATING :
DYSLIPIDEMIA :

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 11 June 2002.

BACKGROUND

On 04 July 2000, applicant filed international application No. PCT/EP00/06230 which claimed priority of an earlier French application filed 06 July 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 January 2001.

On 14 December 2000, a Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 06 January 2002.

On 04 January 2002, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 11 March 2002, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an executed oath or declaration along with a surcharge for filing the oath or declaration after the thirty month period was required.

On 11 June 2002, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Frederic Ausseil, on the grounds that the nonsigning inventor could not be found or reached after diligent effort. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicant Jean-Jacues Berthelon, Daniel Guerrier, Michel Brunet, Jean-Jacues Zeiller, and Francis Contard, on behalf of Frederic Ausseil and a statement of facts under 37 CFR 1.47(a) provided by Dr. Philippe Briet.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the \$130 petition fee, charged to applicant's deposit account. Item (3) is satisfied with the statement of the last known address of non-signing inventor Frederic Ausseil.

With respect to item (2), applicant argues that Frederic Ausseil cannot be found or reached after diligent effort.

Inability to Find or Reach Nonsigning Inventor After Diligent Effort

With regard to the petitioner's inability to find or reach a nonsigning inventor after diligent effort, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

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The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be

made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner provides the declaration of Dr. Philippe Briet, Scientific Director, LIPHA, S.A., the apparent assignee, to prove the inability to locate Frederic Ausseil. However, in his declaration, Dr. Briet merely declares "that it is impossible now, for us, to obtain a signature from Frederic Ausseil". This statement is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. The efforts undertaken in an attempt to obtain the signature of inventor Frederic Ausseil are not detailed nor is any documentation of attempts to contact Mr. Ausseil provided, as outlined in the MPEP section referenced above.

In sum, the evidence submitted does not support a finding that the nonsigning inventor is unavailable after diligent effort for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.


With regard to the declaration submitted by applicants, the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor. However, the declaration is deficient, in that it does not specify the application to which it is directed, as required by 37 CFR 1.497(a)(2). Thus, the declaration does not satisfy the requirements of 37 CFR 1.47(a).

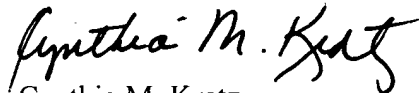
CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.


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